

The opinion in support of the decision being entered today
is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHRISTOPHER B. HEWETT

Appeal 2006-2827
Application 09/883,893
Technology Center 3600

Decided: August 23, 2007

Before WILLIAM F. PATE, III, MURRIEL E. CRAWFORD, and
DAVID B. WALKER, *Administrative Patent Judges*.

Opinion by WALKER, *Administrative Patent Judge*.

Dissenting opinion by PATE, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant seeks our review under 35 U.S.C. § 134 of the Examiner's final rejection of claims 40-47 and 54. We have jurisdiction under 35 U.S.C. § 6(b). We reverse.

THE INVENTION

Appellant claims a method of providing tissues in a shower stall including a tissue dispensing device for retaining a heavy-duty tissue and a disposal device to permit convenient disposal of the waste tissue. The dispensing and disposal devices are located in the moist areas of the bathroom, such as shower, bathtub, sauna, or steam room (Specification 2:21-25). Claim 40, the only independent claim remaining in the application, is representative of the subject matter on appeal.

40. A method of providing tissues in a shower stall comprising the steps of:

A) providing a tissue dispenser having a tissue dispenser station containing tissues to be dispensed, and a tissue disposal station for receiving used tissues, the tissue dispenser station separated from the tissue disposal station by a wall and having a tissue dispensing orifice, the tissue disposal station having a tissue disposing orifice; and

B) mounting the tissue dispenser at the shower stall above floor level.

THE REJECTIONS

The Examiner relies upon the following as evidence in support of the rejections:

Cole	US 3,089,586	May 14, 1963
Yates	US 3,095,087	Jun. 25, 1963
Wilson	US 5,669,085	Sep. 23, 1997

The following rejections are before us for review.

1. Claims 40-45 and 54 are rejected under 35 U.S.C. § 103(a) as unpatentable over Yates in view of Wilson.
2. Claims 40, 44, and 46-47 are rejected under 35 U.S.C. § 103(a) as unpatentable over Cole in view of Wilson.

ISSUE

The issue before us is whether Appellant has shown that the Examiner erred in rejecting the following claims under 35 U.S.C. 103(a): (1) claims 40-45 and 54 as unpatentable over Yates in view of Wilson; and (2) claims 40, 44, and 46-47 as unpatentable over Cole in view of Wilson. The dispositive issue is whether Wilson teaches the placement in the shower of a combination tissue dispenser/disposal, such as those taught by Yates or Cole.

Rather than repeat the arguments of Appellant and the Examiner, we make reference to the Briefs and the Answer for their respective details. Only those arguments actually made by Appellant have been considered in this decision. Arguments which Appellant could have made but chose not to make in the Briefs

have not been considered and are deemed to be waived. *See* 37 C.F.R.
§ 41.37(c)(1)(vii) (2004).

FINDINGS OF FACT

We find the following enumerated findings to be supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427, 7 USPQ2d 1152, 1156 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

1. Yates discloses a combination tissue dispenser station and disposal station (Yates, col. 1, ll. 9-11, Figs. 1-3). The tissue dispenser station is separated from the tissue disposal station by a wall 19 (Yates, col. 2, ll. 4-12, Fig. 1-3).
2. Yates further teaches a tissue dispensing orifice 17 (Yates, col. 2, ll. 12-14, Fig. 1), and a tissue disposing orifice (Yates, col. 3, ll. 49-57).
3. Yates shows the tissue dispenser station overlying the tissue disposal station with the tissue dispensing orifice facing upwardly and the tissue disposing orifice facing downwardly (Yates, Figs. 1-5).
4. Wilson teaches “a multifunction bathroom device which may be utilized either to provide a water-resistant closure for soap used in the bathtub or shower or in the bathroom as a bathroom tissue cover to provide a water-resistant closure for the bathroom environment” (Wilson, col. 2, ll. 35-39).

5. Wilson does not teach mounting, or any reason for mounting, the multifunction bathroom device in the shower stall for use as a tissue dispenser (Wilson, *passim*).
6. Wilson teaches that “the sloping cover can be attached to the wall attachment mounting frame with a smaller overhang so as to prevent shower water or water splashed directly on the pivotal sloping cover from entering into the water-resistant closure” (Wilson, col. 2, l. 65 – col. 3, l. 2). The mounting frame is shown on the rear portion of the multifunction bathroom device (Wilson, Fig. 1-3).
7. Cole teaches a tissue dispensing station 11 with an orifice 13 and a tissue disposal station 15 having an orifice (Cole, col. 1, ll. 45-56, Fig. 1).
8. Cole does not teach that the dispensing station and the disposal station are separated by a wall (Cole, *passim*).

PRINCIPLES OF LAW

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734, 82 USPQ2d 1385, 1391 (2007).

The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of

skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966). See also *KSR*, 127 S.Ct. at 1734, 82 USPQ2d at 1391 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”). The Court noted that “[t]o facilitate review, this analysis should be made explicit.” *KSR*, 127 S.Ct. at 1740-41, 82 USPQ2d at 1396. (citing *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”)). However, “the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *Id.*

A factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning. See *Graham*, 383 U.S. at 36, 86 S.Ct. 684 (warning against a “temptation to read into the prior art the teachings of the invention in issue” and instructing courts to “‘guard against slipping into the use of hindsight’ ” (quoting *Monroe Auto Equipment Co. v. Heckethorn Mfg. & Supply Co.*, 332 F.2d 406, 412 (C.A.6 1964))).

KSR, 127 S.Ct. at 1742, 82 USPQ2d at 1397.

In *KSR*, the Supreme Court emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” *id.* at 1739, 82

USPQ2d at 1395, and discussed circumstances in which a patent might be determined to be obvious. In particular, the Supreme Court emphasized that “the principles laid down in *Graham* reaffirmed the ‘functional approach’ of *Hotchkiss*, 11 How. 248.” *KSR*, 127 S.Ct. at 1739, 82 USPQ2d at 1395 (citing *Graham v. John Deere Co.*, 383 U.S. 1, 12 (1966) (emphasis added)), and reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* The Court explained:

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, §103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.

Id. at 1740, 82 USPQ2d at 1396. The operative question in this “functional approach” is thus “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.*

The Supreme Court stated that there are “[t]hree cases decided after *Graham* [that] illustrate this doctrine.” *Id.* at 1739, 82 USPQ2d at 1395. “In *United States v. Adams*, ... [t]he Court recognized that when a patent claims a structure already known in the prior art that is altered by the mere substitution of one element for another known in the field, the combination must do more than yield a predictable

result.” *Id.* at 1739-40, 82 USPQ2d at 1395. It nevertheless rejected the Government's claim that Adams' battery was obvious. In doing so, the Court relied upon the corollary principle that when the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious. *Id.* at 1740, 82 USPQ2d at 1395. (citing *United States v. Adams*, 383 U.S. 39, 51-52 (1966)). *Sakraida and Anderson's-Black Rock* are illustrative – a court must ask whether the improvement is more than the predictable use of prior art elements according to their established function.” *Id.*

ANALYSIS

A. Rejection of claims 40-45 and 54 under 35 U.S.C. § 103(a) as unpatentable over Yates in view of Wilson.

The Examiner found that it would have been obvious for one to mount a combination tissue dispenser and disposal on a shower wall as taught by Wilson, “because Wilson protects the tissue from shower spatter, persons often have runny or congested noses needing clearing while in the shower or persons need tissues for localized cleaning while in the shower” (Answer 5-6). The only discussion of “persons often have runny or congested noses needing clearing while in the shower or persons need tissues for localized cleaning while in the shower,” as cited by the Examiner, appears not in the prior art but in the Specification. *See, e.g.*, Specification, 1:15-18 (“Use of these tissues in the dry areas of the bathroom does not result in the most effective cleansing of the nasal passages, because the mucus

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contained in the nasal passages is not as loose and easy to expel in the dry areas of the bathroom as it is in the areas that are moister and wetter, such as a shower, bathtub, sauna or steam room.”). The Examiner’s justification to combine Yates with Wilson thus is based on impermissible hindsight analysis. *KSR*, 127 S.Ct. at 1742, 82 USPQ2d at 1397.

The Examiner further found that “Wilson '085 expressly describes its fixture as being mountable in a shower or bathtub stall: Wilson '085 discloses contents including tissue dispensers and portable accessories.” (Answer 6-7). In response to the latter statement, the Appellant argues that

To the extent that such a statement is intended to imply that Wilson discloses to place a toilet tissue dispenser in a shower or bathtub stall, the statement is incorrect. The type of dispenser that Wilson describes as being mountable in a shower or bathtub is a soap dispenser (see column 2, lines 35-39 and 41-46). Wilson also discloses a toilet tissue dispenser but does not disclose mounting it at a bathtub or shower stall.

(Reply Br. 1).

Wilson teaches “a multifunction bathroom device that may be utilized *either* (1) to provide a water-resistant closure for soap used in the bathtub or shower; *or* (2) in the bathroom as a bathroom tissue cover to provide a water-resistant closure for the bathroom environment.” (Finding of Fact 4) (emphasis and numbering added). Appellant is correct that Wilson does not teach locating the multifunction bathroom device in the shower as a bathroom tissue cover. When mounted in the shower, Wilson teaches the multifunction device is a soap dispenser not a tissue dispenser. Wilson makes no other mention of tissue in connection with the

multifunction device than its use as a bathroom tissue cover in the bathroom environment, which it distinguishes from the bathtub or shower. Thus, Wilson teaches the use of the multifunction device in the shower as a soap dispenser and as a bathroom tissue cover outside the shower.

Moreover, Wilson teaches the multifunction bathroom device as a water resistant closure for a roll of toilet tissue, not a box of tissues with an integral disposal device as disclosed in Yates. Neither Yates nor Wilson provides any reason for mounting a combination tissue dispenser and disposal in a shower. While it may appear obvious in hindsight to mount a combination tissue dispenser and disposal in a shower, we see no reason from the prior art relied upon by the Examiner why one having ordinary skill in the art would have added this feature to the method of Yates absent the Appellants' teaching to do so. The Examiner thus erred in rejecting claims 40-45 and 54 as obvious over Yates in view of Wilson.

B. Rejection of claims 40, 44, and 46-47 under 35 U.S.C. § 103(a) as unpatentable over Cole in view of Wilson.

The Examiner relies on Wilson for essentially the same modification (mounting in the shower) as he does above. For the same reasons as noted above, this rejection is improper. In addition, the base reference, Cole, fails to disclose a wall between the tissue dispenser and the tissue disposal as required by claim 40 (Finding of Fact 8). The Examiner has thus failed to make a prima facie case of obviousness of claims 40, 44, and 46-47 over Cole in view of Wilson.

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CONCLUSIONS

We conclude that Appellant has shown that the Examiner erred in rejecting claims 40-47 and 54 under 35 U.S.C. § 103(a).

DECISION

The decision of the Examiner to reject claims 40-47 and 54 under 35 U.S.C. § 103(a) is reversed.

REVERSED

JRG/vsh

DISSENTING OPINION

William F. Pate, III, Administrative Patent Judge, dissenting.

I respectfully dissent.

As I understand it, my colleagues are reversing based on the rationale that “[n]either Yates nor Wilson provides any reason for mounting a combination tissue dispenser and disposal in a shower.” My response is that Wilson does not provide a reason, he just does it. Wilson mounts a tissue dispenser in a shower.

In my colleague’s Findings of Fact, they emphasize the alternative uses of Wilson quoting from col. 2, ll. 35-39. They state that Wilson discloses “a multifunctional device which may be utilized *either* to provide a water-resistant closure for soap used in the bathtub or shower or in the bathroom as a bathroom tissue cover to provide a water resistant closure for the bathroom environment.” See Finding of Fact 4.

In fact, the first full sentence of Wilson states, “[t]he present invention pertains to a water-resistant multifunctional bathroom fixture which may be utilized as either *or for both* providing a water-resistant soap dish holder or as a bathroom tissue fixture which prevents water spray from interfering with soap or bathroom tissue located in the bathroom”(emphasis supplied). Accordingly, Wilson is at least *suggestive* of mounting a tissue holder in a shower. Perhaps

Wilson is contemplating usage of his device in an RV environment where a toilet is commonly located in a shower for space-saving purposes.

However, my real argument with the majority position is that Wilson fully teaches the two claimed manipulative steps of the independent claim 40 on appeal. Wilson is a tissue dispenser. Wilson is mounted in a shower. This is all that the claim requires. *When Wilson is first mounted in a shower, before soap or tissue is placed therein, has not the method step of mounting a tissue dispenser in a shower been performed? Isn't the underlying intention of a user who mounts Wilson in a shower completely irrelevant as to whether the method step at issue has been performed?* While it is true that Wilson does not teach both a dispenser and disposal station in the same device, Yates has been cited to show that this method step or feature is well known. The combination of Yates with Wilson would have been obvious for the reason given by Yates of insuring other articles such as clean tissues or the surroundings are not contaminated by the soiled tissues.

Stepping back a little, I believe it to have been obvious to place tissues and a tissue dispenser anywhere one wishes to blow one's nose. Accordingly, if one wishes to blow one's nose in the shower or perhaps out-of-doors, one of ordinary skill would have found it obvious to provide a waterproof tissue dispenser in such a location. Mounting above the floor level, anywhere, was likewise obvious as a matter of convenience obviating bending or crouching. I see nothing in Appellant's independent claim that would not have been obvious to one of ordinary skill.

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